

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

X CORPORATION,
Petitioner,

v.

STERLING COMPUTERS CORPORATION,
Patent Owner.

Case No. IPR2025-00299
U.S. Patent No. 7,716,217

**PETITIONER'S AUTHORIZED REQUEST FOR ADDITIONAL AND
ROUTINE DISCOVERY**

EXHIBIT LIST

No.	Short Name	Reference
1001	217 Patent	Certified Copy of U.S. Patent 7,716,217
1002	217 File History	Certified File History of 7,716,217
1003	828 Provisional	Certified United States Provisional Patent Application No. 60/758,828.
1004	Houh Decl.	Expert Declaration of Dr. Henry Houh
1005	Houh CV	Curriculum Vitae of Dr. Henry Houh
1006	<u>Dumais</u>	U.S. Patent Application Publication 2007/0016553A1
1007	<u>Kircher</u>	U.S. Patent Application Publication 2003/0195937A1
1008	<u>Krug</u>	Certified Translation of WIPO Patent 2003/023650A2
1009	Sch. Order	Order 32 (Scheduling Order) in <i>Sterling Computers Corporation v. X Corp.</i> , Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024)
1010	Sch. Hr. Tr.	Oct. 21, 2024, Transcript of Initial Pretrial (Scheduling) Conference in <i>Sterling Computers Corporation v. X Corp.</i> , Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024).
1011	Goldberg	David Goldberg, et al., <i>Using Collaborative Filtering To Weave An Information Tapestry</i> , COMMUNICATIONS OF THE ACM, 35:12 (Dec. 1992).
1012	Kennedy	U.S. Patent 6,134,582
1013	Mailk	U.S. Patent Application Publication 2004/0078447
1014	587 Application	International Application PCT/US07/60587
1015	587 File History	File History of PCT/US07/60587
1016	RESERVED	

1017	118 File History	File History of 11/426,118
1018	605 Provisional	Provisional Patent Application NO. 60/693,605.
1019	Shaw	U.S. Patent 6,249,807
1020	Karamchedu	U.S. Patent Application Publication 2004/0054744
1021	Fitzpatrick	U.S. Patent Application Publication 2006/0168029
1022	Yao	U.S. Patent Application Publication 2003/0187937
1023	Segal	Richard Segal, et al., <i>SpamGuru: An Enterprise Anti-Spam Filtering System</i> , CEAS 2004, FIRST CONFERENCE ON EMAIL AND ANTI-SPAM, (July, 2004).
1024	Carlson	U.S. Patent Application Publication 2005/0267973
1025	Sood	U.S. Patent 7,941,491
1026	Kirsch	U.S. Patent Application Publication 2005/0091319
1027	Boykin	P. Oscar Boykin, et al., <i>Personal Email Networks: An Effective Anti-Spam Tool</i> , ARXIV.ORG, 4 (Feb. 2004)
1028	Horvitz	International PCT Application WO2001/069432
1029	Lui	Andrew K. Lui, et al., <i>An Advanced Organizer for Asynchronous Discussion Forums</i> , IEEE (2005).
1030	Claypool	Mark Claypool, et al., <i>Combining Content-Based and Collaborative Filters in an Online Newspaper</i> , ACM SIGIR WORKSHOP ON RECOMMENDER SYSTEMS (Aug. 1999).
1031	Brun	U.S. Patent Application Publication 2007/0168430
1032	Linden	Greg Linden, et al., <i>Amazon.com Recommendations Item-to-Item Collaborative Filtering</i> , IEEE INTERNET COMPUTING (2003).
1033	Frankowski	International PCT Application WO2001/53973
1034	Dabbish	Laura A. Dabbish, et al., <i>Understanding Email Use: Predicting Action on a Message</i> , CHI (2005).
1035	Basu	Chumki Basu, et al., <i>Recommendation as Classification: Using Social and Content-Based</i>

		<i>Information in Recommendation</i> , AAAI-98 PROCEEDINGS (1998).
1036	Melville	Prem Melville, et al., <i>Content-Boosted Collaborative Filtering for Improved Recommendations</i> , PROCEEDINGS OF THE EIGHTEENTH NATIONAL CONFERENCE ON ARTIFICIAL INTELLIGENCE (Jul. 2002).
1037	Alspector	Joshua Alspector, et al., <i>Comparing Feature-Based and Clique-Based User Models for Movie Selection</i> , PROCEEDINGS OF THE THIRD ACM CONFERENCE ON DIGITAL LIBRARIES (1998).
1038	Balabanovic	Marko Balabanovic, et al., <i>Content-Based Collaborative Recommendation</i> , COMMUNICATIONS OF THE ACM (Mar. 1997).
1039	Kussmaul	U.S. Patent 7,860,933
1040	Rose	U.S. Patent 6,202,058
1041	MSFT Comp.	Microsoft Computer Dictionary, 3ed (1997).
1042	Levenshtein	Jan 2005 – Levenshtein Distance – Wikipedia
1043	<u>Marston</u>	U.S. Patent Application Publication 2004/0260710
1044	EX2010 Native	Native version of EX2010
1045	EX2010 Metadata	Windows system metadata for EX2010
1046	Plail Dec.	Declaration of Ethan L. Plail in Support of Petitioner’s Unopposed Motion for <i>Pro Hac Vice</i> Admission Under 37 C.F.R. § 42.10(c)
1047	PHV Plail Dec.	<i>Pro Hac Vice</i> Declaration of Ethan L. Plail
1048 (NEW)	Board’s Authorization Discovery	Patent Trial and Appeal Board’s Correspondence Authorizing Request for Additional and Routine Discovery, November 6, 2025
1049 (NEW)	J. Marston Rough Depo. Tr.	Rough Deposition Transcript of Justin Marston, November 11, 2025

Pursuant to the Board's Authorization (EX1048), Petitioner X Corp. ("Petitioner") submits the following request for additional and routine discovery under 37 CFR § 42.51(b) and a motion to compel production under 37 CFR § 42.52.

With its POR (Paper 17), Sterling submitted a declaration from named inventor Justin Marston. EX2030. Mr. Marston's declaration cites to and relies on communications with counsel from 2004 to 2006 to purportedly corroborate his claim he diligently conceived and reduced to practice the inventions. EX2042 (log). Mr. Marston testifies that "My work as CEO of BlueSpace during this time period is **corroborated** by documents, including **e-mails exchanged with counsel** for BlueSpace **relating** to TransMail."¹ EX2030, ¶¶19, 36, 49, 50, 53, 54, 55.

Based on the communications with counsel, Mr. Marston testifies that he worked on TransMail on 28 days during the critical period (between July 11, 2005 and January 12, 2006), and that he sent "a draft" of the provisional application and "exchanged correspondence" with prosecution counsel "regarding the application" between January 11-12, 2006. *Id.*; EX2030, ¶54-55. Mr. Marston also relies on one unredacted sentence in EX2046 to dispute Jon Fernyhough's inventive contributions. EX2030, ¶32. At deposition, Mr. Marston confirmed that he "reviewed" and "relied" on the documents listed in EX2042 and an unredacted version of EX2046 in forming the opinions in his declaration. EX2049, 245:14-

¹ TransMail is non-practicing product. EX2030, ¶7; EX1049, 34:1-4.

247:8 (“Q. And **your review** of that file **informed your testimony** in your declaration? A. **Everything I read informed the testimony** in my declaration”); 250:16-20 (“you **relied on the parts under those redactions** for when you were drafting your declaration? A. **I must have done** it because ... I saw it.”).

Sterling refuses to produce communications logged in EX2042 or an unredacted EX2046, claiming they are protected by attorney-client privilege.

First, during Mr. Marston’s deposition, Sterling never objected based on privilege to questions about the contents of redacted communications. *See, e.g.*, EX1049, 250:4-15, 235:6-11 (“Mr. Hoffman [(i.e., counsel)] asked who the inventors were on the patent? A. I believe so.”); 239:21-243:19 (no objection to questions about content of documents withheld based on privilege). Sterling failed to preserve its privilege objections. *Second*, Sterling cannot shield these communications from discovery on privilege grounds after Mr. Marston admitted he relied on them to form opinions in his declaration on Sterling’s diligence claims.

In *GEA Process Eng’g, Inc. v. Steuben Foods, Inc.*, IPR2014-00055, Paper 43, at 5 (P.T.A.B. July 21, 2014), the PTAB compelled the patentee to produce a draft declaration because its expert “review[ed] the declaration” and testified “as to the differences between the Omnibus [draft] declaration” and the filed declarations. While draft declarations are privileged, the PTAB explained that reliance on the draft waived the privilege. *Id.* at 5-6. In *Willis Elec. Co. v. Polygroup Macao Ltd.*, 2020

WL 1934425, at *1 (D. Minn. Apr. 22, 2020), a “patent-prosecution attorney” declaration stating that he “ha[d] privileged communications regarding the invention...[that] indicate an invention date at least as early as May 18, 2010” waived privilege over those communications. The Court explained that the “testimony regarding the earlier invention date is premised upon the contents of privileged communications,” and thus waves privilege over those communications. *Id.* at *2. (citing *Milwaukee Elec. Tool Corp. v. Chervon N. Am. Inc.*, 2017 WL 2929522, at *1 (E.D. Wis. July 10, 2017) (“Put simply, a privilege holder cannot be allowed, after disclosing as much as he pleases, to withhold the remainder.”)).

So too here. Sterling cannot rely on Mr. Marston’s testimony “derived from privileged communications” and then withhold those communications. *Id.*

Sterling attempts to distinguish *GEA Process* by arguing that it relates to “work product” and not attorney-client communications. While these privileges are different, the differences relate to “who holds the privilege.” Work product protection is not necessarily waived when disclosed to third parties—i.e., when those third parties share a “common” interest. *Carter v. Gibbs*, 909 F.2d 1450, 1451 (Fed. Cir. 1990). Neither distinction is relevant here.

Sterling also contends that *Willis* is distinguishable because the “waiver of attorney-client privilege was based upon an alleged infringer’s reliance upon an opinion of counsel.” EX1048, 5. Opinions of counsel are not a special class of

privilege. In *Willis*, 2020 WL 1934425, at *2, the alleged infringer moved to compel where the patentee relied on an attorney declaration to assert an earlier conception date. Here—like in *Willis*—the patentee relies on correspondence with its attorney to claim an earlier conception date. It matters not who signs the declaration.

Sterling also contends its did not waive privilege by merely producing its privilege log. Not so. Sterling relies on the **substance** of documents in the privilege log to support its arguments. EX2049, 245:14-247:8; 250:16-20; 224:4-17; 229:18-5. The patentee in *Willis* made the same argument as does Sterling. *See Willis Elec.*, 2020 WL 1934424, at *2 (“Willis compares the content of Mr. Fonder's IPR declaration to the limited information a party is required to disclose on a privilege log.”). The Court rejected this argument, determining the IPR declarant testified that “the **substance** of privileged communications he had with [his attorney] ‘indicate[d]’ a May 18, 2010 invention date.” *Id.* (emphasis added). At bottom, “[i]t would be unfair to allow [Sterling] to disclose Mr. [Marston’s] opinion that was derived from privileged communications without giving [X Corp.] access to the materials he used to form that opinion.” *See id.*

Sterling also contends it did not waive privilege because it only revealed “facts,” not legal advice. This distinction is immaterial. By relying on these communications as evidence for diligence, Sterling waived privilege over **all** the relied-on communications. *Willis*, 2020 WL 1934425, at *2. Indeed, Mr. Marston

believed the withheld information was “completely benign”—not privileged. EX1049, 256:4-257:6.

Sterling also contends that the Board invited it to submit evidence of diligence. *See* Paper 13 (“Decision”), 33. Sterling has **not** submitted evidence. It has made assertions based on evidence it refuses to disclose. Regardless, the Board’s invitation did not sanction Sterling’s use of privilege as both a sword and shield.

Because Mr. Marston relied on and cites these documents in his declaration, they should have been produced as part of routine discovery. *See* 37 C.F.R. § 42.51.

Petitioner also requests that the documents be produced under Additional Discovery. *See* 37 C.F.R. § 42.51(b)(2). Evaluating the factors set out in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPRw2012-00001, Paper 26 (P.T.A.B. March 5, 2013) (precedential), the requested discovery is in the interest of justice.

Factor 1: X Corp.’s tailored request for document specific identified documents show Mr. Marston’s alleged inventive diligence. **Factor 2:** The requested documents are from 20 years ago and would not reveal Sterling’s current litigation position.

Factor 3: X. Corp has no means to generate these documents on its own. **Factor 4:** X Corp.’s request is easily understandable—production of the documents listed in EX2042 and an unredacted version of EX2046. **Factor 5:** the burden is not high as these documents have been collected, reviewed, and logged.

Dated: November 13, 2025

Respectfully Submitted,

/s/David Okano

David Okano

(Reg. No. 66,657)

WHITE & CASE LLP

3000 El Camino Real

2 Palo Alto Square Suite 900,

Palo Alto, CA 94306

david.okano@whitecase.com

Telephone: (650) 213-0363

Attorney for Petitioner X Corp.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I hereby certify that on this 13th day of November, 2025, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by express mail on the following counsel:

PADMANABHAN & DAWSON, PLLC
Attn: Britta Loftus & Sri Sankaran
9800 Shelard Parkway, Suite 120
Minneapolis, MN 55441

Dated: November 13, 2025

Respectfully Submitted,
/s/David Okano
David Okano
(Reg. No. 66,657)
WHITE & CASE LLP
3000 El Camino Real
2 Palo Alto Square Suite 900,
Palo Alto, CA 94306
david.okano@whitecase.com
Telephone: (650) 213-0363

Attorney for Petitioner X Corp.